

U.S. Application No. 10/625,989
Reply to Office Action of February 4, 2008
Amendment dated August 1, 2008

REMARKS

Claims 1, 2, 4-7, 9-21, 25, and 27-33 were pending in the present application. Claims 6-28 and 30-33 remain withdrawn from consideration as allegedly being drawn to non-elected subject matter. By this Amendment, Applicants have amended claims 1, 2, 4, and 5, and have added new claims 34-36. Support for the claim amendments and new claims can be found throughout the specification and claims as originally filed. Specifically, support can be found, *inter alia*, at paragraphs [0036], [0039], and [0054] of the specification. The present Amendment does not introduce any new matter and thus, its entry is respectfully requested. Upon entry of the present Amendment, claims 1-2, 4-5, 29, and 34-36 will be pending and under examination.

U.S. Application No. 10/625,934, now U.S. Pat. No. 7,396,855

Applicants wish to inform the Examiner that previously co-pending, related U.S. Application No. 10/625,934 has now issued as U.S. Pat. No. 7,396,855. Applicants also note that a continuation of the above-noted U.S. patent has been filed and is now pending. The continuation application is U.S. Application No. 12/167,813, filed July 3, 2008.

The February 4, 2008 Office Action

Examiner's Rejection of Claims 1 and 2 under 35 U.S.C. §102(b)

The Examiner rejected claims 1 and 2 under 35 U.S.C. §102(b), as allegedly anticipated

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by the previously cited Alvira reference. According to the Examiner, Alvira teaches the separation of R-equol from the S-equol, which meets the limitation of a composition comprising R-equol. The Examiner further stated that “R-equol is the only required component for the composition claims.”

In response, Applicants first note that the rejected claims in fact recite “consisting essentially of” language, rather than “comprising” language. Nevertheless, without conceding the correctness of the Examiner’s position, but to expedite allowance of the present application, Applicants have amended claim 1 to recite a “pharmaceutical” composition. Applicants believe this amendment renders the Examiner’s rejection under 35 U.S.C. §102(b) moot, and thus, respectfully request reconsideration and withdrawal of the rejection.

Examiner’s Rejection Under 35 U.S.C. §103

The Examiner rejected claims 4, 5, and 29 under 35 USC 103(a), as allegedly obvious over Alvira (as applied to claims 1 and 2 in the anticipation rejection noted above). According to the Examiner, Alvira teaches all that is recited in claims 1-2 except for the R-equol being present in 90 or 96% enantiomeric purity. In the Examiner’s opinion, an artisan provided the technique of Alvira would have been able to optimize the purity of R-equol through routine experimentation even to the level of 90 or 96% purity. In commenting on Applicants’ previously submitted remarks, the Examiner stated that Applicants’ claims “employ ‘consisting essentially of’ language, which does not exclude the S-equol.”

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In response, without conceding the correctness of the Examiner's position, but to expedite allowance of the present application, Applicants refer to the amendments made herein, which Applicants believe render moot the Examiner's rejection. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §103.

Examiner's Double Patenting Rejection

The Examiner provisionally rejected claims 1 and 2 on the grounds of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1 and 2 of copending Application No. 10/625,934. The Examiner stated that although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application consists essentially of R-Equol and the '934 application consists essentially of S-Equol. According to the Examiner, "Neither invention excludes the other enantiomeric form.

First, as noted above, the '934 patent has now issued as U.S. Patent No. 7,396,855. In response to the Examiner's double patenting rejection, Applicants respectfully request that such rejection be held in abeyance until the indication of allowable subject matter in the present application. At that time, Applicants will consider submission of an appropriate Terminal Disclaimer.

In view of the above remarks and the claim amendments presented herein, Applicants believe all of the Examiner's concerns set forth in the February 4, 2008 Office Action have been overcome and the present claims are in condition for allowance.

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The Examiner is invited to telephone the undersigned if it is deemed to expedite
allowance of the application.

Respectfully submitted,



By _____

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